

REMARKS

Claims 1-6, 8-15, 17-22, 31-33, and 36-40 are pending. Claims 7, 16, 23-30, 34, and 35 are cancelled. Claims 1-6, 8, 9, 31-33, and 38 are amended and new claim 41 is added. Support for the amendments and new claims can be found throughout the specification and claims as filed and as indicated below. Upon entry of the amendments and new claim, claims 1-6, 8-15, 17-22, 31-33, and 36-41 will be pending.

Support for the amendment of claims 1 and 38, which now recite “wherein the electric field is between 0.1 – 10 kV/cm where the mammalian cell and fusion partner contact” can be found at page 8, lines 11-20 of the specification.

Rejections under 35 U.S.C. § 112, Second Paragraph

Claims 1-6, 8-15, 17-22, 31-33, and 36-40 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite.

With respect to claim 1, from which claims 2-6, 8-15, 17-22, 31-33, and 36 depend, and claim 38 from which claims 39 and 40, the Examiner alleges that the term “kV/cm” is confusing. Applicants respectfully disagree. Nevertheless, without acquiescing to the rejection and solely to facilitate prosecution, Applicants have amended claims 1 and 38 to recite “where the mammalian cell and fusion partner contact,” thereby obviating the rejection. Thus, this basis for the indefiniteness rejection should be withdrawn.

With respect to claims 1, 9, and 38 and the claims that depend therefrom (claims 2-6, 8, 10-15, 17-22, 31-33, 36, 37, 39, and 40), the Examiner alleges that the phrase “sufficiently small to permit the selective fusion” of the cell and the fusion partner is indefinite because the maximum size of the microelectrode is situation-dependent and therefore open-ended. Applicants respectfully disagree.

35 U.S.C. § 112, second paragraph, requires that a patent specification conclude with “one or more claims particularly pointing out and distinctly claiming the subject matter that the applicant regards as his invention.” The definiteness requirement set forth in 35 U.S.C. § 112 is satisfied where “the claims define the metes and bounds of the claimed invention with a reasonable degree of precision and particularity.” *In re Venezia*, 530 F.2d 956, 958.

The fact that the claim term is situation dependent does not render the term indefinite. *See Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986) (holding that a claim directed to a chair leg “*so dimensioned*” as to be insertable through a car doorframe was not indefinite merely because the term was situation dependent). As in *Orthokinetics*, Applicants’ claim is not indefinite merely because the size of the microelectrode is situation dependent. As in *Orthokinetics* where the size of the doorframe defined the dimensions of a chair leg that was insertable, so in the present case the size of the cell and fusion partner define the size of the microelectrode to be used. Applicants note that the Examiner’s hypothetical example is inapplicable because the use of the term “micro,” which modifies electrode, clearly indicates the scale of the envisioned electrode. The term “micro” could not be applied to an electrode that was centimeters or meters in width. The rejection appears to be based, at least in part, on the grounds that the claim is broad. However, “[b]readth of a claim is not to be equated with indefiniteness. *In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971).” See MPEP § 2173.04.

The Examiner alleges that claims 2-6, 9-15, and 31-33 are indefinite for lacking sufficient antecedent basis for “the electrical field in step B” because the electrical field is recited in step C. Applicants thank the Examiner for bringing this to their attention. Claims 2-5, 8, 31, and 32 have been amended to recite “the electrical field in step C.” Accordingly, this basis for the indefiniteness rejection should be withdrawn.

With respect to claims 6 and 33, the Examiner alleges that the phrase “a microchip of a suitable design for combinatorial synthesis of fusion products” is unclear. In particular, it is alleged that the term “suitable design” is purely functional and conveys no structural information. Without acquiescing to the rejection and solely to facilitate prosecution, Applicants have amended claims 6 and 33. As amended the claims recite “a microchip for combinatorial synthesis of fusion products.” Thus, this basis for the indefiniteness rejection should also be withdrawn.

Regarding claims 9 and 10, the Examiner alleges that the phrase “such as” renders the claim indefinite. Applicants respectfully disagree. Nevertheless, claim 9 has been amended, thereby obviating the rejection.

The Examiner alleges that claim 6 recites “one electrode(s) is (are). . .” and one alternative of the phrase is “one electrodes are” which is grammatically unclear. Claim 6 has been amended to recite “one or more electrodes are.”

The Examiner alleges that claim 32 recites “several electrodes,” but that claim 3, from which it depends only recites two electrodes. Claims 3 and 32 are amended to recite “two or more electrodes.”

Applicants respectfully request reconsideration and withdrawal of the rejections based on the foregoing comments and amendments.

CONCLUSION

In view of the above amendment, applicant believes the pending application is in condition for allowance.

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